

Application Ser. No. 09/498,944

**REMARKS**

Applicant would like to once again thank the Examiner for her courtesy and assistance during a much earlier Interview held April 10, 2006. During the Interview, Applicant discussed the claim rejections under 35 U.S.C. §102 in view of Le Bourgeois, which is the same reference cited for the present §102 rejections. During the April-2006 Interview, Applicant proposed various revisions to the claims and the Examiner indicated that these proposed claim revisions would distinguish the claimed invention from Le Bourgeois. Applicant then submitted replacement claims in its Response dated April 17, 2006 to the earlier Office Action dated February 27, 2006 to overcome the §102 rejection.

Subsequently, in the most recent Office Action dated February 26, 2007, the Examiner submitted a new basis for rejection of independent claims 1 and 67 based upon 35 U.S.C. §112, asserting that Applicant's reference to a "document server" in its claims is purportedly new matter. Applicant respectfully disagrees with the Examiner's contention and provides herein specific references to its specification which includes the drawings to clearly point out that the claimed "document server" is not new matter and hence, the §112 rejection of claims 1 and 67 should be withdrawn and the claims passed to allowance.

Applicant respectfully points out that exact terms need not be used in haec verba to satisfy the written description requirement of the first paragraph of 35 U.S.C. §112. (See *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)). Applicant also submits that the following discussions provide adequate and substantial correspondence between the language of the claims and the language of the specification. (See 37 CFR §1.121(e)).

***Claim Rejections- 35 USC § 112***

Examiner has rejected independent claims 1 and 67 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description

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requirement. Examiner contends that the claims contain new subject matter (i.e., "a document server") which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant respectfully traverses the Examiner's rejection and submits that the claimed "document server" is sufficiently described in Applicant's specification to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the application was filed.

Applicant further submits that a "document server" is well known to one skilled in the art, and hence, it is unnecessary for Applicant to describe the document server (i.e., the server and document repository) in great detail. Regardless, Applicant contends that the claimed document server of Applicant's invention has been described in substantial and sufficient detail to allow one skilled in the art to practice Applicant's invention. Support for the inclusion of "document server" in claims 1 and 67 is found in Applicant's specification at least in Figure 6, Figure 10, at page 10, lines 6-9, and, at page 28, last paragraph. These references are discussed in greater detail below.

First, Applicant calls to Examiner's attention Figures 6 and 10 of Applicant's specification. Figure 6 clearly illustrates the presence of a "Document Server" in bidirectional communication with the Network. One skilled in the art would clearly understand the role and function of the "Document Server" of Figure 6 sufficiently to practice Applicant's invention. Further, Figure 10 clearly illustrates "Server 902" including a "document repository 930." Applicant wishes to point out that the combination of the Server 902 and document repository 930 substantially corresponds to the document server referenced in Applicant's earlier replacement claims.

At page 10, lines 6-9, referring to Figure 3, Applicant's specification describes the function of the document repository of the claimed invention, which is part of the "document server":

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"FIG. 3 is a flow chart illustrating a method for **accepting documents into a repository and formatting documents for user access** according to a specific embodiment of the invention. According to the invention, **the document repository will hold the system's provided documents and will participate in restricting access to only authorized access.**" (Emphasis added.)

Applicant submits that the above narrative is descriptive of a document server.

Again, at page 28, last paragraph, Applicant describes the "server 902" which is in communication with the "document repository 932":

"In an alternate embodiment, client side software 918 may include the ability to determine the location of the selected **documents in the secure document repository 932** based on desired text information and **forward that information to the server.** Such document location information may be determined by the **server 902** again without making protected data 930 available to the user 912 prior to confirmation of an activating transaction 927 such as proper payment or other authorization." (Emphasis added.)

Applicant once again submits that the above narrative is descriptive of a document server.

One skilled in the art recognizes that a server can be defined as an individual computer on a network acting as a service or resource provider to client computers, by sharing the resources within the network infrastructure. The online Encarta Dictionary defines a file server, or server, as a computer that other computers access, and more specifically, as a computer in a network that stores application programs and data files accessed by the other computers in the network.

As evidenced by the references described above, Applicant asserts that its specification describes in sufficient detail a "server" including a "document

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repository," i.e., a "document server," to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the application was filed. As such, Applicant believes the Examiner's rejection has been overcome and respectfully requests that the Examiner withdraw this rejection and pass claims 1 and 67 to allowance.

**Claim Rejections  
35 U.S.C. §102(b)**

Applicant respectfully traverses Examiner's rejection of claims 1 and 67. Claims 1 and 67 were earlier rejected under 35 U.S.C. § 102(b) as being anticipated by LeBourgeois (International PCT Publication No. WO 98/42098, published on 09/24/1998) based upon the Examiner's re-interpretation of the claims resulting from Examiner's §112 rejection of claims including the term, "document server." In view of Applicant's submission herewith, which overcomes the §112 rejection, the Le Bourgeois reference is deemed to be distinguished by the earlier amended claims. Accordingly, all claim rejections under 35 U.S.C. § 102 are likewise deemed overcome.

Applicant respectfully submits that its arguments and the evidence presented have overcome the Examiner's §112 rejection of claims 1 and 67. Consequently, in light of the earlier-submitted claim amendments which the Examiner acknowledged during the April-2006 Interview would overcome the present §102 rejections, Applicant submits that claims 1 and 67 are therefore in proper form for allowance. Applicant respectfully requests that the rejection of claims 1 and 67 be withdrawn and claims 1 and 67 be passed to allowance.

Consequently and further, Applicant also respectfully traverses the Examiner's rejection of claims 2, 3, 15, 17-21, 55-66, 68-75 and 78-85 which also stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, in light of Applicant's faithful amendment of parent independent claims 1 and 67 according to Examiner's recommendations during the Interview and Applicant's clarification of terminology

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to overcome a similar §112 rejection, Applicant asserts that the rejection of the above claims is now moot as they depend from the now allowable parent independent claims 1 and 67. Claims 2, 3, 15, 17-21, and 55-66, further define the invention of claim 1, which Applicant respectfully asserts is now allowable. Claims 68-75 and 78-85 further define the invention of claim 67 which Applicant respectfully asserts is now allowable. Consequently, Applicant submits that claims 2, 3, 15, 17-21, 55-66, 68-75 and 78-85 are also allowable by reason of their dependency from their respective parent independent claims 1 and 67. Applicant therefore respectfully requests withdrawal of the rejections of claims 2, 3, 15, 17-21, 55-66, 68-75 and 78-85 and passage of claims 2, 3, 15, 17-21, 55-66, 68-75 and 78-85 to allowance.

### Conclusion

Therefore, Applicant respectfully requests favorable consideration of the above remarks, withdrawal of the present rejections, and passage of Claims 1-3, 15, 17-21, 55-75 and 78-85 to allowance.

Should the Examiner deem it helpful, she is cordially invited and encouraged to contact the Applicant's Attorney, Michael A. Glenn, at (650) 474-8400 for any reason which would advance the instant application to allowance.

Respectfully submitted,



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